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EXAMINER

PAULA, CESAR B

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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2178

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/330,056

Applicant(s)

TAKAHARA, KOHJI

Examiner

CESAR B PAULA

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This action is responsive to the amendment, and formal drawings filed on 9/20/02.

This action is made Final.

2. Claims 1-21 are pending in the case. Claims, 1, 8, and 15 are independent claims.
3. The rejections of claims 1-3, 8-10, and 15-17 under 35 U.S.C. 102(b) as being anticipated by Wang et al, hereinafter Wang (Pat.# 5,490,217, 2/6/96) have been withdrawn as necessitated by the amendment.
4. The rejections of claims 4-7, 11-14, and 18-21 under 35 U.S.C. 103(a) as being unpatentable over Wang have been withdrawn as necessitated by the amendment.

Priority

5. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 10-179,731 filed in Japan on 6/11/1998, which papers have been placed of record in the file.

Drawings

6. The formal drawings filed on 9/20/02 have been approved by the draftsman.

Specification

7. The amendment to the specification filed in this amendment has been entered in the file.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-21 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Applicant states that support for the newly added limitation: "format image information is 'of a sheet separate from the sheet document image information'" (p.5,L.16-21). The Examiner is unable to see how fig.3 teaches format image information is 'of a sheet separate from the sheet document image information'. Fig. 3 seems to be only displaying a document image information only. There is no indication that the document image information format is separate from the *document image information*.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-7 recite the limitation "document image formation" in line 10 of claim 1. There is insufficient antecedent basis for this limitation in the claim. It seems that the Applicant is referring to document image information.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4-7, 11-14, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al, hereinafter Wang (Pat.# 5,490,217, 2/6/96), in view of Barnes, "10 Minute Guide to Windows 3.1", SAMS, p.79-83, 1992.

Regarding independent claim 1, Wang discloses the scanning and storing of a document image sheet(s) and a machine readable image code (separate, and unique entity from the image document sheet) storing document format in a network environment having users connected to each other via a computer network. The image and related information are stored in a database server (col. 2, lines 24-67, col.4, line 54-col.5, line 21, fig. 6-10).

Moreover, Wang discloses the decoding or determination of the machine readable image code for verifying whether, the bar code is included in one of the sheet(s) (col. 3, L. 23-c.5,L.67).

Further, Wang discloses the storage and indexing the document, by a database server, not by the user, according to the machine readable image code (col. 4, lines 40-col.5, line 4).

Furthermore, Wang fails to explicitly disclose *storing image information in various folders*. However, Barnes teaches the storage of related documents in one directory folder (p.79). It would have been obvious to one of ordinary skill in the art at the time of the invention,

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to have combined the teachings of Wang, and Barnes, because Barnes teaches above the organizing of documents, such as to prevent scattering, and disarray.

Claim 2 is directed towards a computer system for implementing the system found in claim 1, and therefore is similarly rejected.

Regarding claim 3, which depends on claim 1, Wang discloses the storage of the document pages as a single document (col. 2, lines 40-67).

Regarding claim 4, which depends on claim 2, Wang discloses the scanning and storing in a database server, of a document image and a machine readable image code storing document format between the time the document start information is input to the time the input ends (col. 2, lines 24-67, col.4, line 54-col.5, line 21). Wang fails to explicitly disclose: *determine whether the format image information input by the image information inputting device is related to document start information and document end information*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have determine where the document starts, and where it ends, because Wang teaches the scanning of document into a computer system (col. 4, lines 54-67).

Claim 5-7, 11-14 is directed towards a computer system for implementing the system found in claim 4, and therefore is similarly rejected.

Claims 8-10 are directed towards a computer system for implementing the system found in claims 1-3, and therefore are similarly rejected.

Claims 15-17 are directed towards a method for implementing the system found in claims 1-3 respectively, and therefore are similarly rejected.

Claims 18-21 are directed towards a method for implementing the system found in claim 4, and therefore are similarly rejected.

Response to Arguments

14. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "When that format sheet is detected the subsequent sheet image document information is appropriately processed" p.7,L.1-4) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)

Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label **"PROPOSED"** or **"DRAFT"**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

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Arlington, VA, Sixth Floor (Receptionist).

CBP

12/2/02


STEPHEN S. KONG
PRIMARY EXAMINER